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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,484	12/12/2001	James Rist	FREEH2.003AUS	6786

20995	7590	06/07/2007
KNOBBE MARTENS OLSON & BEAR LLP		
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EXAMINER	
HOEL, MATTHEW D	

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
06/07/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/020,484	Applicant(s) RIST, JAMES	
	Examiner Matthew D. Hoel	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-25 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-25 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

2. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

4. Determining the scope and contents of the prior art.
5. Ascertaining the differences between the prior art and the claims at issue.
6. Resolving the level of ordinary skill in the pertinent art.
7. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 19 to 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hand (U.S. pre-grant publication 2002/0125627 A1, application 09/804,333) in view of Winters (provisional application 60/337,409, published as U.S. patent 7,014,029 B2 and pre-grant publication 2003/0111316 A1) and further in view of Judd (U.S. patent 6,564,997 B1).

9. As to Claim 19: '627 discloses all of the limitations of Claim 19, but lacks specificity as to first and second counters and accepting the bills at the same rate. '627 teaches a gaming machine (Para. 14). '627 teaches a bill acceptor for receiving bills tendered, the bill acceptor comprising a sensor for evaluating each inserted bill after it

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has been inserted in the bill acceptor and outputting a signal which is used by the gaming machine to determine whether to accept or reject that bill (Para. 17, bill returned if not validated, Para. 18). '627 teaches annunciators on the bezel of the bill acceptor (Fig. 3). '409, however, teaches a controller that maintains a first counter and a second counter (Pages 5 to 7 generally), the controller incrementing the first counter on each occurrence that the gaming machine accepts a bill that has been inserted into the gaming machine (Faux + Real, Para. 19, Page 5) and incrementing the second counter on each occurrence that the gaming machine rejects a bill that has been inserted into the bill acceptor (Faux, Para. 19, Page 5), the controller further computing a bill acceptance rate using the first and second counters as inputs (Para. 19, Page 5). '409 notifies authorized personnel in the event of possible fraud (Para. 19, 2nd bullet, Page 5). '627 teaches "reject" indicators and "counterfeit bill" indicators (Para. 21). The 103 combination of '627 and '409 would thus activate an annunciator when the computed bill acceptance rate falls below a predetermined value. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the first and second counters and threshold of '409 to the gaming device of '627. '627 is able to count the number and type of each note passing through the acceptor (Para. 27) and determines the authenticity of each note (Para. 16), so '627 has the counters necessary to implement the counting of '409. '627 has reject and counterfeit indicators (Para. 21) which fill an analogous role to the personnel notification of '409 (Page 6). '627 analogously monitors the gaming device over a network (Para. 14) like '409 (Page 7, last para. and Page 8, first para.). The examiner notes that while '409 detects

fraudulent coins and '627 detects fraudulent bills, the threshold rates and counters are usable in either type of detection, as the rejection threshold rates and counters do not pertain to physical characteristics of bills and coins. The advantage of this combination would be to avoid a false alarm each time there is a worn or old bill, and to adjust the percentage of rejected bills to protect the house's margin and at the same time not inconvenience players with false alarms ('409, Para. 9, Page 3). '997, however, teaches the bill acceptor continuing to receive and evaluate each inserted bill according to the same criteria regardless of the computed bill acceptance rate (10:33-11:11; must be in tilt condition for period of time before game is taken out of play, 10:40-47, 10:63-65, Fig. 11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the continued acceptance of '997 to the combination of '627 and '409. The time period has the effect and advantage of eliminating spurious outages of service by requiring the rejection threshold to be exceeded for a period of time (10:40-48,63-65; Fig. 11), which is analogous and additional to '409's use of a rejection threshold to reduce the likelihood of spurious outages inconveniencing the game player.

10. As to Claim 20: '627 teaches the annunciator being arranged in an area of the bill acceptor that receives bills and is visible external of the gaming machine (Fig. 3).

11. As to Claims 21 to 23: These claims pertain to the bill acceptor having rejection rates of 10%, 20%, and 30%. These new limitations are supported by Pages 2 and 3 of the applicant's specification. The applicant has not stated the purpose of these rejection rates. Do they have to do with the weight or texture of the bills' paper, or the

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color of the bills' ink, or the authenticity of the patterns on the bills, or the amount of tearing of the bills? The applicant also does not say whether these rejection rates pertain to specific nations' currencies or specific denominations or if they pertain to visual, infrared, or magnetic, etc., sensors. The applicant merely states on Page 2 of the specification that these limits can be set by the operator. They are presumably set empirically without any analysis as to why they should be set at these rejection rates. It appears that '487, or the applicant's invention would perform equally well for their intended purposes when set to these rejection rates. Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have set the rejection rates of '487 to 10%, 20%, or 30% as these rejection rates are mere design choices that have no patentable weight over '487's specification.

12. As to Claim 24: '487 teaches in 3:48 to 61 that the bill acceptor is responsive to each subsequent fraudulent attempt and that each subsequent attempt triggers the restricted acceptance range, essentially resetting the number of times until the normal restricted range each time there is a subsequent fraudulent attempt during the countdown period of the restricted acceptance range.

13. As to Claim 25: Winters ('409), however, on Pages 3 and 4 discloses a fraudulent transaction of a person feeding fraudulent coins into the machine, resulting in a higher rejection rate, and the rejection rate being reported over the network via phone lines.

14. As to Claim 27: The discussion of Claim 19 is incorporated herein as these limitations have already been addressed. '409 teaches in Fig. 1 monitoring a bill acceptance rate of the bill acceptor, the bill acceptance rate being computed depending

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on the cumulative value of both the counters and updated following each bill insertion. '627 teaches annunciators on the bezel of the bill acceptor (Fig. 3). '409, however, teaches a controller that maintains a first counter and a second counter (Pages 5 to 7 generally), the controller incrementing the first counter on each occurrence that the gaming machine accepts a bill that has been inserted into the gaming machine (Faux + Real, Para. 19, Page 5) and incrementing the second counter on each occurrence that the gaming machine rejects a bill that has been inserted into the bill acceptor (Faux, Para. 19, Page 5), the controller further computing a bill acceptance rate using the first and second counters as inputs (Para. 19, Page 5). '409 notifies authorized personnel in the event of possible fraud (Para. 19, 2nd bullet, Page 5). '627 teaches "reject" indicators and "counterfeit bill" indicators (Para. 21). The 103 combination of '627 and '409 would thus activate an annunciator when the computed bill acceptance rate falls below a predetermined value. '627 teaches activating an annunciator comprising activating a visual indicator located in a bill-receiving zone of the bill acceptor (Fig. 3).

Response to Arguments

15. Applicant's arguments with respect to claims 1-16, 18-25, 27, and 28 have been considered but are moot in view of the new ground(s) of rejection. The indicated allowability of claims 26 and 29 is withdrawn in view of the newly considered reference(s) to Juds ('997). Rejections based on the newly cited reference(s) are above. The modification of continuing to accept bills using the same criteria would have destroyed the previous Bell reference (6,722,487) for its intended purpose as it uses a

narrower range of criteria when the rejection rate exceeds a threshold. Additionally, most references either stop all activity when the threshold is exceeded or reject all bills or coins when the threshold is exceeded. The Bell reference was actually better for the applicant's intended purpose than the claim language as amended at the time of the last rejection. The limitation of claims 26 and 29 were obvious in a sense, but not legally obvious in light of the Bell reference. The examiner believes the limitations of claims 26 and 29 are obvious in light of the Juds ('997) reference as outlined in the rejections above. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. This office action is non-final. The examiner respectfully disagrees with the applicant as to the claims' condition for allowability.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew D. Hoel
Patent Examiner
AU 3714

Xuan M. Thai
Supervisory Patent Examiner
Art Unit 3714

DETAILED ACTION

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

2. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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XUAN M. THAI
SUPERVISORY PATENT EXAMINER

TC3700